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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,050

11/21/2003

Leon A. Pintsov

F-710

3291

7590

06/26/2007

Pitney Bowes Inc.  
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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

2616

MAIL DATE

DELIVERY MODE

06/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/719,050	Applicant(s) PINTSOV ET AL.	
	Examiner FIRMIN BACKER	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on March 27<sup>th</sup>, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of application No 10/716051 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 50, the phrase "receive or generate" renders the claim indefinite because it is unclear which of these two processes is being performed in claimed invention. It is obvious that these are competing processes. Applicant is advised to choose which one to be performed in the claim. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-52 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Montgomery et al (U.S. PG Pub No. 2003/0101143).

8. As per claim 1, 34 and 50, Montgomery et al disclose a secure indicia printing system (*end user computer system, 308*) and method for generating and printing an indicium (*indicia, 100, 200*) on an object (*mail piece, 100*), comprising a printer (*printer 404*) for printing the indicium a scanner (*scanning station, 484*) for scanning an image of other printed material from the object, a processor communicating with the scanner to receive the image for processing the image to abstract the characterizing information from the image, the characterizing information being selected to fit within the indicium; whereby a meter (, the meter communicating with the processor to receive the characterizing information, and having a communications link for receiving other information from another information source, and communicating with the printer, for cryptographically authenticating the characterizing information and other information, generating the indicium to be representative of the cryptographically authenticated information; and controlling the printer to print the indicium on the object; and the object's relationship to the indicium can be verified by regenerating the characterizing information from the other printed material and comparing the regenerated characterizing information with

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characterizing information recovered from the indicium, and copies of the indicium cannot easily be used without detection on other objects which do not include the other printed material (*see abstract, figs 2, 3, 4, 5, 8, 19-22, pps 0006, 0034-0038, 0113-0114, 0116, 0134-0138*).

9. As per claims 2-33, 35-49 and 51-52, they are dependent on claims 1, 34 and 50 and do not further limit the scope of the invention. Their limitations are clearly taught/disclosed by Montgomery et al. Therefore they are rejected by the same rationale.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

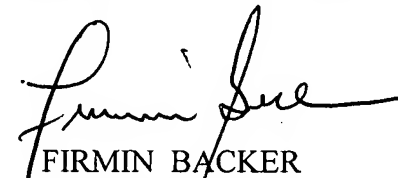
Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMIN BACKER whose telephone number is 571-272-6703.

The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



FIRMIN BACKER  
Primary Examiner  
Art Unit 3621

June 12, 2007